



Attorney Docket # 3397-94PDV4

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Vilho NISSINEN et al.

Serial No.: 10/687,194

Filed: October 16, 2003

For: Use of recycled calcium carbonate in the  
treatment of a paper, board or nonwoven product

Examiner: HALPERN, Mark  
Group Art: 1731

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Signature

September 19, 2007

Date of Signature

Commissioner for Patents  
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Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

SIR:

Applicants request review of the Final Rejection in the above-referenced application. No  
amendments are being filed with this request.

The review is requested for the reasons set forth on the following pages.

### **Rejections under 35 U.S.C. §112**

Claim 62 stands rejected under 35 U.S.C. §112, 2<sup>nd</sup> ¶, as indefinite. More specifically, the Examiner alleges claim 62 is non-statutory because it includes the USE and the METHOD OF MAKING of recycled calcium carbonate. Reconsideration of this rejection is respectfully requested.

Applicants note that 35 U.S.C. §100(b) defines the term “process” for the U.S. Patent laws and states that: “The term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition or material, or material”. Thus a use is merely a subset of the group of statutory classes defined as process claims. Accordingly, within the context of the disclosed invention, claim 62 defines a process using the recycled calcium carbonate to treat a paper, board or nonwoven product.

Furthermore, to use recycled calcium carbonate for treatment of a paper, board or nonwoven product requires obtaining the recycled calcium carbonate. Accordingly, the steps for obtaining or preparing the recycled calcium carbonate to be used are properly recited as a part of the overall claimed process for the use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product.

In view of the foregoing, the rejection of claim 62 under 35 U.S.C. §112 should be withdrawn.

### **Rejection of Claims under 35 U.S.C. §102**

Claim 62 stands rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,759,258 (“*Sohara*”).

The Examiner states that *Sohara* discloses forming calcium carbonate from the residues of deinking of wastepaper process and using the formed recycled calcium carbonate for treatment of

paper. However, Applicant notes that the specific step of “calcining into lime” for preparing the recycled calcium carbonate recited in claim 62 is not disclosed by *Sohara*.

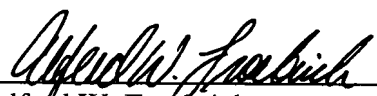
*Sohara* discloses that a deink residue (DIR) is first heated and then turned to mineral ash (see col. 3, lines 35-40). The mineral ash is then used by *Sohara* to form the precipitated calcium carbonate (PCC) (see col. 3, lines 40-48 and 62-67; and col. 4, lines 1-9). Cols. 6-7 of *Sohara*, which are referred to by the Examiner in the rejection, also disclose that the DIR is incinerated to produce mineral ash, which is subsequently used for forming PCC (see e.g., col. 6, lines 37-42; and col. 7, lines 58-67).

Since *Sohara* discloses heating deink residue to form mineral ash, *Sohara* fails to disclose “calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board, or nonwoven product”, as recited in independent claim 62.

Accordingly, independent claim 62 is deemed allowable, and withdrawal of the rejection of claim 62 under 35 U.S.C. §102(b) is in order.

Applicant respectfully submits that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,  
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Dated: September 19, 2007